

REMARKS

Claims 1-49 are pending in the instant application and stand rejected by the examiner. Claims 1 and 39 are independent claims. Reconsideration is respectfully requested in light of the amendments and remarks contained herein.

Claim Rejections – 35 U.S.C. §§ 102, 103

Claims 1-8, 21-27, 33-34, and 39-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Network Working Group RFC 2633 (June 1999) (Ramsdell) and in further view of Klein (U.S. Patent No. 6,496,853). Claims 9-14, 16-17, 28-32, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and in further view of Thorne (U.S. Patent No. 5,958,005). Claims 15 and 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and Thorne and further in view of official notice. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and Thorne and further in view of Carpenter (U.S. Patent No. 5,544,316). Finally, claim 49 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ramsdell in view of Klein and in further view of official notice. These rejections are traversed.

Claim 1

Claim 1 has been amended to recite that the message characteristics of the outgoing message are controlled based on the content of the outgoing message. This amendment is supported by paragraph [0052] of the application at issue.

It is respectfully submitted that the combination of Ramsdell and Klein fails to teach or suggest all of the recited limitations of amended claim 1. More specifically, the combined references fail to teach or suggest that the message characteristics of the

outgoing message are controlled based on the content of the outgoing message. The Examiner's position is recited on pages 2-3 of the final office action of April 17, 2009, and is repeated in the advisory action. The office action alleges that "Ramsdell teaches determining an outgoing message is related to a previously received message when the outgoing message's destination address is the same as the previously received message's origin address." The office action further cites to Klein, alleging that "messages are determined to be related based on their contents (Klein: Figure 7, col 11, lines 43-52; See also col 11, lines 27-38)." More specifically, FIG. 7 of Klein describes comparing text of previously received and sent messages to determine relationships among those previously received and sent messages.

Claim 1 expressly recites that the message characteristics of the outgoing message are controlled based on the content of the outgoing message. It is respectfully submitted that the combination of Ramsdell and Klein fails to teach or suggest anything at all to do with the content of the outgoing message, let alone the detailed and explicit requirements of claim 1. The cited portions of Ramsdell and Klein fail to even once mention the content of the outgoing message. It is absurd to think that one skilled in the art would be inclined to put together the teachings of Ramsdell and Klein to develop the method of claim 1 because the cited references would never suggest the idea of examining the content of the outgoing message at all. The position recited in the office action makes a jump that is not supported by the evidence of record. This hindsight reconstruction of the claim at issue is impermissible. Because the cited portions of the references fail to teach or suggest any examination of the content of an outgoing message, let alone the determination that an outgoing message is related to a previously received message based

upon the messages having a portion of message content in common, where the message characteristics of the outgoing message are controlled based on the content of the outgoing message, as is required by claim 1, it is respectfully requested that the § 103 rejection of claim 1 be withdrawn.

Claim 39

With respect to the other independent claim, claim 39 has been amended in a similar manner as claim 1. Accordingly, for similar reasons as claim 1, claim 39 is allowable and should proceed to issuance.

Claim 3

Claim 3 has been amended to recite that a received message comprises an attachment that is common to a previously received attachment received with the previously received message, and wherein the step of determining whether the outgoing message includes a portion of a previously received message comprises the step of determining whether the outgoing message includes the attachment that is common to the previously received attachment. This amendment is supported by paragraph [0090] of the application at issue. In rejecting claim 3, the office action cites to column 9, lines 6-9, citing to FIG. 3 of Klein at 340, specifying that “message contents” include attached documents. Klein at 340 is describing inserting message contents from a previous message into a new response message. While Klein mentions an attachment, there is no determination of whether an outgoing message is related to a previous message by determining whether the outgoing message includes the attachment that is common to a previously received attachment. The office action is again making a jump that is not supported by the evidence. Klein never makes any determinations based on an outgoing

message having an attachment that is common to a previously received attachment. Because the office action makes no allegation of such a teaching in Ramsdell, it is respectfully submitted that the combination of Ramsdell and Klein does not teach or suggest the claimed feature. Therefore, it is respectfully requested that the § 103 rejection of claim 3 be withdrawn.

It is noted that the assignee has not presented arguments herein with respect to the other dependent claims in the instant application. This is done without prejudice to the assignee's right to present arguments regarding each of the dependent claims at any point in the future. Further, since all of the dependent claims in the instant application depend from independent claims that are patentable over the cited references, the dependent claims are themselves patentable for at least the reasons set forth with respect to the independent claims.

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CONCLUSION

For the foregoing reasons, the assignee respectfully submits that the pending claims are allowable. Therefore, the assignee respectfully requests that the examiner pass this case to issuance.

Respectfully submitted,

Date: January 14, 2010

A handwritten signature in black ink, appearing to read "MATTHEW W. JOHNSON", written over a horizontal line.

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